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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/115,654 07/15/98 SHIBATA

Y 98092

QM12/0909  
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EXAMINER
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DEXTER, C	
ART UNIT	PAPER NUMBER

3724

DATE MAILED:

09/09/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trad marks

# Office Action Summary

Application No.  
**09/115,654**

Applicant(s)

**Shibata**

Examiner

**Clark F. Dexter**

Group Art Unit

**3724**



☐ Responsive to communication(s) filed on \_\_\_\_\_.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 1 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claims

☒ Claim(s) 1-17 is/are pending in the application.

Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

☐ Claim(s) \_\_\_\_\_ is/are allowed.

☐ Claim(s) \_\_\_\_\_ is/are rejected.

☐ Claim(s) \_\_\_\_\_ is/are objected to.

☒ Claims 1-17 are subject to restriction or election requirement.

## Application Papers

☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Interview Summary, PTO-413

☒ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## **DETAILED ACTION**

### ***Election/Restriction***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - Ia. Claims 1-5, drawn to a circular saw with a first lock means and a dust cover, classified in class 83, subclasses 490 and 701.
  - Ib. Claims 1-4 and 6, drawn to a circular saw with a first lock means and a specific sensor, classified in class 83, subclasses 490 and 522.15.
  - IIa. Claims 1 and 7-10, drawn to a circular saw with a second lock means and a dust cover, classified in class 83, subclass 485 and 701.
  - IIb. Claims 1, 7-9 and 11, drawn to a circular saw with a second lock means and a specific sensor, classified in class 83, subclasses 485 and 522.15.
  - IIIa. Claims 1 and 12-16, drawn to a circular saw with both a first and second lock means and a dust cover, classified in class 83, subclasses 471.2 and 701.
  - IIIb. Claims 1, 12-15 and 17, drawn to a circular saw with both a first and second lock means and a specific sensor, classified in class 83, subclasses 471.2 and 522.15.
2. Claims 1-17 have been restricted such that the patentability of the invention is presumed to lie in the details of the particular group (e.g. the first lock means and the dust cover of Group I). It is noted that if claim 1 as originally filed is part of an elected group and determined to be patentable, rejoinder of claims 1-12 will be considered.

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3. The inventions are distinct, each from the other because of the following reasons:

Groups I-III

4. Inventions III and I are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the claims drawn to the subcombination of Group II are evidence that the combination of Group III as claimed does not require the particulars of the subcombination of Group I for patentability. Further, the subcombination of Group I has separate utility as disclosed in the first embodiment of the application.

5. Inventions III and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the claims drawn to the subcombination of Group I are evidence that the combination of Group III as claimed does not require the particulars of the subcombination of Group II for patentability. Further, the subcombination of Group II has separate utility as disclosed in the second embodiment of the application.

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6. Inventions I and II are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, each invention (I and II) has separate utility as disclosed in the two embodiments. See MPEP § 806.05(d).

Group Ia vs Ib

7. Inventions of groups Ia and Ib are separate inventions. They are distinct because the invention of group Ia does not require the specific details of the sensor (e.g., detector plate) of group Ib for patentability as evidenced by the omission thereof from group Ia, and the invention of group Ib does not require the dust cover of group Ia for patentability as evidenced by the omission thereof from group Ib.

Group IIa vs IIb

8. Inventions of groups IIa and IIb are separate inventions. They are distinct because the invention of group IIa does not require the specific details of the sensor (e.g., detector plate) of group IIb for patentability as evidenced by the omission thereof from group IIa, and the invention of group IIb does not require the dust cover of group IIa for patentability as evidenced by the omission thereof from group IIb.

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Group IIIa vs IIIb

9. Inventions of groups IIIa and IIIb are separate inventions. They are distinct because the invention of group IIIa does not require the specific details of the sensor (e.g., detector plate) of group IIIb for patentability as evidenced by the omission thereof from group IIIa, and the invention of group IIIb does not require the dust cover of group IIIa for patentability as evidenced by the omission thereof from group IIIb.

10. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

11. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clark Dexter whose telephone number is (703) 308-1404.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Rinaldi Rada, can be reached at (703)308-2187.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703)308-1148. The fax numbers for this group are: formal papers - (703)305-3579; informal/draft papers - (703)305-9835.

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Communications via Internet e-mail regarding this application, other than those under 35 USC 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [rinaldi.rada@uspto.gov].

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 USC 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark Office on February 25, 1997 at 1195 OG 89.



**Clark F. Dexter**  
**Primary Examiner**  
**Art Unit 3724**

cfid  
September 8, 1999